

### **REMARKS**

Applicant appreciates the consideration of the present application afforded by the Examiner. Claims 1-7, 9 and 11-18 are pending. Claims 8 and 10 are canceled. Claims 1, 12 and 13 are independent and have been amended. These amendments are being made without conceding the propriety of the Examiner's rejection, but merely to timely advance prosecution of the present application. Favorable reconsideration and allowance of the present application are respectfully requested in view of the amendments and remarks made in this response.

### **Drawings**

The Examiner had objected to the drawings under 37 C.F.R. § 1.83(a) as not showing "the authentication processing and information storing apparatus having a personal information storing device, requester authentication device, access level setting device, personal information output device".

Applicant notes that 35 U.S.C. § 113 and 37 C.F.R. § 1.81(a) state:

[t]he Applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented.

Applicant submits that a drawing representation of the authentication processing and information storing apparatus having a personal information storing device, requester authentication device, access level setting device, personal information output device are not necessary for the understanding of the invention. This is evidenced by the fact that the Examiner has not asserted that the invention is not understood without the drawings.

Also, applicant had amended the claims to read "circuitry" instead of "device." Applicant had previously noted that, according to the 37 C.F.R. § 1.83(a):

- (a) The drawing in a non-provisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for

a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (*e.g.*, a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings. *See MPEP 1.83(a)*

Thus, based on this regulation, Applicant noted that *conventional features* should be illustrated in the drawing in the form of a graphical drawing symbol or labeled representation. Figure 6 of the application shows a “requester authentication section”, “an access level setting section”, “personal information output section” in the form of a labeled rectangular box. Since the circuitry in these sections are “conventional features”, and in view 37 C.F.R. § 1.83(a), Applicant submits that the drawings are in compliance with the MPEP.

The Examiner asserted that because applicant made the remark that these features are “conventional” that such features are thus “old and well known,” thus basically asserting that it is prior art. **First, Applicant has never stated that these features are prior art.** Second, while the Examiner provided a dictionary definition of “conventional” this definition is not in line with any legal understanding of this term as it relates to what “prior art” is considered. Something can be well know and still not be prior art. The term “conventional” and “prior art” are not analogous legal terminology. They cannot be used interchangeably and 37 C.F.R. 1.83(a) does not assert such.

Therefore, it is respectfully requested that the objection be withdrawn.

### **Claim Rejections under 35 U.S.C. § 103**

Claims 1, 7, 9, 11 and 13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Deindl et al. (“Deindl”, U.S. 6,031,910) in view of Houvener et al. (“Houvener”, U.S. 6,070,141) further in view of Rankl et al. (“Rankl”, Smart Card Handbook, 2<sup>nd</sup> Edition). Claims 1, 7, 9, 11 and 13 stand alternately rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Deindl et al. (“Deindl”, U.S. 6,031,910) in view of Houvener et al. (“Houvener”, U.S. 6,070,141) further in view of Rankl et al. (“Rankl”, Smart Card Handbook, 2<sup>nd</sup> Edition) further in view of Examiner’s Official Notice. Claims 2-6, 12 and 14-18 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Deindl et al.

(“Deindl”, U.S. 6,031,910) in view of Houvener et. al. (“Houvener”, U.S. 6,070,141) further in view of Rankl et al. (“Rankl”, Smart Card Handbook, 2<sup>nd</sup> Edition) further in view of Schneider et. al. (“Schneider”, U.S. 6,105,027). These rejections are respectfully traversed.

Amended independent claims 1 and 12 clearly recite, *inter alia*, **“image capturing circuitry for generating the requester characteristic information by capturing an image of the requester while the information storing apparatus is retained by the owner”**. The Examiner asserted in the previous Office Action that, as claimed, the feature noted above is interpreted as intended use language. Thus, Applicant has amended claims 1 and 12 to recite the unique feature structurally. Because of the claimed feature, the amended claims provide *an unexpected advantage* in that the information storing apparatus is *able to set the access level for the personal information and outputs the personal information at any place* since image capturing circuitry for generating the requester characteristic information by capturing an image of the requester while the information storing apparatus is retained by the owner (*See ¶64 of the Applicant’s Specification*). None of the references disclose or suggest this feature or advantage it provides.

Houvener, moreover, merely suggests using an image capturing apparatus for taking fingerprints or retinal images (*see Column 9, Lines 16-20*), but is completely silent with regard to the claimed unique feature “image capturing circuitry for generating the requester characteristic information by capturing an image of the requester while the information storing apparatus is retained by the owner”.

Amended independent claim 13 clearly recites, *inter alia*, **“generating the requester characteristic information by capturing an image of the requester while the computer readable medium is retained by the first person”**. The Examiner asserted in the previous Office Action that, as claimed, the feature noted above is interpreted as intended use language. Thus, Applicant has amended claims 13 to recite the unique feature such that it is not construed as intended use language. Because of the claimed feature, the amended claims provide *an unexpected advantage* in that the information storing apparatus is *able to set the access level for the personal information and outputs the personal information at any place* since a computer readable medium containing computer executable instructions for authenticating a requester of

personal information, comprising generating the requester characteristic information by capturing an image of the requester is retained by the owner\_(See ¶64 of the Applicant's Specification). None of the references disclose or suggest this feature or advantage it provides.

Houvener, moreover, merely suggests using an image capturing apparatus for taking fingerprints or retinal images (See Column 9, Lines 16-20), but is completely silent with regard to the claimed unique feature "A computer readable medium containing computer executable instructions for authenticating a requester of personal information, comprising . . . generating the requester characteristic information by capturing an image of the requester while the computer readable medium is retained by the first person."

Thus, it is respectfully submitted that Deindl, Houvener and Rankl, alone or in combination, do not teach or suggest amended independent claims 1 and 13 or their dependent claims. It is also respectfully submitted that Deindl, Houvener, Rankl and Schneider, alone or in combination, do not teach or suggest amended independent claim 12, or its dependent claims. Accordingly, withdrawal of the rejections are respectfully requested.

**CONCLUSION**

In view of the above amendment and remarks, Applicant believes the pending application is in condition for allowance.

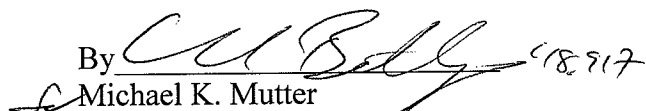
Should there be any outstanding matters that need to be resolved in the present application; the Examiner is respectfully requested to contact Charu K. Mehta, Reg. No. 62,913 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

By

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